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REISSUE LITIGATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Patent Application  
For PATENT NO. 5,711,100

WILLIAM A. ELMER

Serial No. 74,598

Filing Date: June 14, 1993

For: VEHICLE ADVERTISING  
SIGN, SYSTEM AND  
METHOD

DECLARATION OF  
PAUL BERG

Reissue file: 10/098648

I, Paul Berg, declare as follows:

1. I am over the age of 18 and am competent to testify. The matters set forth herein are based upon my own personal knowledge.
2. I am a resident of the state of Michigan.
3. I am the owner and President of Motor City Manufacturing, Inc. located at 23440 Woodward Avenue, Ferndale, Michigan.
4. Motor City Manufacturing, Inc. is in the business of commercial displays and advertisements. Motor City, Inc. was incorporated in May of 1994.
5. Prior to my ownership of Motor City, Inc., I was employed at and later became the owner of, ICC Fabricating, Inc. ("ICC") which used to be a supplier to the pizza business since approximately 1979. This was a family owned business which I was involved with on a full-time basis starting in 1986; and prior to that on a part-time basis when I used to work for my father at the business while attending high school. In 1990, my brother and I purchased ICC.
6. ICC products included car top vehicle advertising signs.

7. I have personal knowledge and am very familiar with products supplied to the pizza industry. I have personal knowledge regarding the concepts, functions, and designs of car top vehicle advertising signs.

8. ICC's original car top vehicle advertising sign was known as the "CTSI" (Car Top Sign 1) which ICC was manufacturing, marketing, and selling at least as early as 1982. (See Exhibit A which is a true and correct copy of a photograph taken in approximately 1982 showing the "CTSI" sign)

9. ICC's product, the "CTSI" car top vehicle advertising sign, was a plastic device that was hand fabricated out of sheets of plastic. The CTSI had two ends, two sides, and a base that came together to form an enclosed hollow body.

10. The "CTSI" advertising signs were translucent and the message panels (sides) and the ends were screwed together and also screwed into the base.

11. The car top vehicle advertising sign was attached to the vehicle via a modified ski rack--which rack was attached to the vehicle with bolts.

12. The base of the sign was attached to the ski rack via a foot assembly that consisted of a big rubber grommet that was about an inch and a half in diameter and an inch thick. This rubber grommet foot had a hole in the middle for a screw and bolt to attach.

13. The purpose of the rubber grommet foot was to provide flexibility; it was a means for attachment that allowed this necessary and obvious need for flexibility for a car top vehicle advertising sign.

14. ICC then began manufacturing, marketing and selling the "CTSII" vehicle advertising signs. This car top vehicle advertising sign was also a plastic device, fabricated out of sheets of plastic, with ends, sides, and a base that came together to form an enclosed hollow body. These signs were also translucent and screws were used to attach the message panels to the base. (See Exhibit B: Pizza Today Publication 10/88)

15. The "CTSII" was attached to the top of the vehicle by means of suction cups. The suction cups had rubber grommets that provided additional flexibility. The suction cups were fastened to the base by means of an imbedded stud.

16. The "CTSII" was a patented product. These patents were invented by Marlin Berg and marketed, advertised, and sold by ICC. These patents were not disclosed by William Elmer in his application for U.S. Patent No. 5, 711, 100, and in my opinion should have been disclosed as prior art. (See Exhibit C: U.S. Patent Nos. 4671004 and 4787163)

17. ICC manufactured, marketed and sold the "CTS III" vehicle car top sign that was a "Quad" shaped sign. This car top vehicle advertising sign was also a plastic device, fabricated out of sheets of plastic, with ends, sides, and a base that came together to form an enclosed hollow body. These signs were also translucent and screws were used to attach the message panels to the base. (See Exhibit D: Pizza Today Publication 01/90) These signs were affixed to the top of the vehicle using the flexible suction cups as described above.

18. From my ordinary experience in this area, the use of magnets was the next obvious step, from the use of suction cups and straps, for temporary attachment of car top vehicle advertising signs to be affixed to the top of a vehicle.

19. ICC manufactured, marketed, and sold what was known as the Magnetic Roof Rider. This sign was advertised as a "one piece all plastic, stackable design for easy storage. Four sides of illuminated copy area gives you the most message area of any topper on the market. Four custom made heavy-duty *magnetic feet*, protected by rubber boots, that are totally adjustable and form fitting to the roof." (See Exhibit E: Viva Italia Publication 07/93)

20. The Magnetic Roof Rider was an advertising sign that formed a hollow, translucent sign having two ends, two sides, and a top.

21. The ICC Magnetic Roof rider utilized a magnet designed by ICC that was just slightly taller than what is commonly known as an "RB-80 magnet." The RB-80 magnet is a catalog magnet assembly manufactured by several different companies, for example Adams Manufacturing. ICC could have used the RB-80 magnet assembly on its Magnetic Roof Rider.

The catalog RB-80 magnet assembly is the same magnet assembly as described by William Elmer in his Patent No. 5, 711, 100 and was not invented by Mr. William Elmer. (See Exhibit F attaching Elmer U.S. Patent No. 5, 711, 100.)

22. The magnets on the ICC Magnetic Roof Rider were attached with a flexible rubber grommet to allow a range of motion so that the magnets could conform to the top of the car. The rubber grommets provided the same functionality as what has been called a "flexible sleeve" in U.S. Patent No. 5, 711, 100.

23. I have reviewed and am familiar with the design, specifications, and drawings of U.S. Patent No. 5, 711, 100 issued to Mr. William Elmer on January 27, 1998. (See Exhibit F) I am also familiar with Mr. Elmer's products distributed through his company HTH, Inc.

24. Mr. Elmer's company, HTH, Inc. is a supplier to the pizza industry of various products, including car top vehicle advertising signs.

25. Mr. Elmer and I have attended the same tradeshow over the years, and our companies have advertised in the same pizza industry magazines and publications prior to the time Mr. Elmer filed his patent applications on June 14, 1993. (See Publications attached as Exhibit B: October 1988; Exhibit D: January 1990; Exhibit G: 04/89; Exhibit H: 06/90; Exhibit I: 09/90; Exhibit J: 11/90; Exhibit K: 04/91) Mr. Elmer and I have met on several occasions, including prior to the time Mr. Elmer filed his application for Patent No. 5, 711, 100.

26. All of the ICC products described above, including the Magnetic Roof Rider, were advertised in publications and sold prior to Mr. Elmer's filing of his application for U.S. Patent No. 5, 711, 100, and are products that the USPTO should have had before it when considering Mr. Elmer's application for patent number 5, 711, 100 and should consider now in light of Mr. Elmer's reissue application serial number 74,598. The "CTSII" product was a patented product that in my opinion should have been disclosed as prior art. (See Exhibit C)

27. I knew back in the late 1980's and early 1990's that use of magnets was the next obvious step for temporary attachment of car top vehicle advertising signs to be affixed to the top of a vehicle; and in fact ICC had a product utilizing magnets with a flexible means of attachment

prior to Mr. Elmer's application on June 14, 1993 for patent No. 5, 711, 100. (See Exhibit E: Viva Italia Publication 07/93) The ICC Magnetic Roof Rider should also, at a minimum, been disclosed as prior art, in my opinion to the USPTO office.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct:

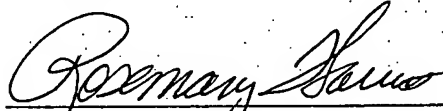
EXECUTED this 30 day of October, 2002 at 4:00pm

  
PAUL BERG

CERTIFICATE OF MAILING

I hereby certify that this DECLARATION OF PAUL BERG is being deposited with the United States Postal Service as Express Mail on the 1<sup>st</sup> day of November, 2002, in an envelope addressed to the following:

- and
- (1) The Assistant Commissioner for Patents, BOX DAC, Washington, D.C. 20231,
  - (2) Mr. Herbert L. Allen, Allen, Dyer, Doppelt, Franjola & Milbrath, P.A.  
255 South Orange Avenue, Suite 1401, Orlando, FL 32802-3791  
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Rosemary Harnett